

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANTS: James D. Kelly and Michael L. Regal
APPLICATION NO.: 10/669,119 (REI OF 5,996,036)
FILING DATE: September 22, 2003
TITLE: BUS TRANSACTION REORDERING IN A COMPUTER SYSTEM HAVING
UNORDERED SLAVES
EXAMINER: Glenn Allen Auve
GROUP ART UNIT: 2111
ATTY. DKT. NO.: 18602-08098 (P2080R1C1)

CERTIFICATE OF ELECTRONIC (EFS-WEB) TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with 37 C.F.R. § 1.8(a)(i)(C) from the Pacific Time Zone of the United States on the local date shown below.

Dated: October 15, 2008 By: /Sabra-Anne R. Truesdale/
Sabra-Anne R. Truesdale, Reg. No. 55,687

REPLY BRIEF

This Reply Brief is filed in accordance with 37 C.F.R. § 41.41 in response to the Examiner's Answer, mailed on August 15, 2008.

Argument

The legal issue to be decided in this matter is whether the examiner has correctly required that, in a continuation of a broadening reissue, "the newly broadened claims should be broadened in a way that is covered under the original reissue declaration filed in the reissue parent which was filed within two years of issue of the original patent issuance." (Examiner's Answer, page

4.) In fact, there is no such requirement in the law. The only support that the examiner has offered for his position was: (1) a citation to *In re Doll*, 419 F.2d 925, 164 U.S.P.Q. 218 (CCPA 1970); and (2) a discussion of public policy. But neither of these supports the examiner's enhanced requirement for reissue declarations.

In the Examiner's Answer, the examiner makes much of the fact that *Doll* discusses whether the "original" reissue oath/declaration was adequate to support the later-filed claims. But the court in *Doll* was merely addressing whether the declaration was adequate, after dealing with the primary issue about whether claims may be broadened outside the scope of the original declaration. *Doll*, 419 F.2d at 928. The court was in no way suggesting any additional requirement that later-filed claims must be supported by an original declaration, as the examiner implies.

Furthermore, the Examiner's Answer completely ignores the fact that *Doll* already considered — and soundly rejected — the same policy arguments that the examiner has advanced to support his rejection in this case. The *Doll* court explained:

The solicitor further makes reference to rights of the public. We have considered that argument but believe it unnecessary to comment thereon in detail in view of our interpretation of section 251 except to note, as does appellant, that 35 U.S.C. 252 provides safeguards for the public by virtue of its intervening rights provisions.

Id. One could not follow *Doll* and yet still be persuaded by the examiner's arguments based on public notice. *Doll*'s rejection of the same arguments that the examiner has made here demonstrates that the examiner misinterpreted and misapplied that case.

Finally, the examiner has attempted to distinguish *Doll* on the ground that the broadened claims in *Doll* were presented after two years in the first reissue application, whereas in this case the broadened claims were presented in a continuation application. This is a distinction without

a difference, and the examiner has provided no explanation for why the distinction would be meaningful. In both cases the public would not have been on notice of the scope of the broadened claims until after the two-year period, and in both cases the public would be on notice of the intent to broaden within that period. Accordingly, the examiner's policy arguments would apply equally to this case as they would in *Doll*. But as noted above, the court in *Doll* has already considered and rejected those arguments.

Appellants also pointed out that the examiner has refused to follow the Office's own guidebook. Responding to this, in the Examiner's Answer, the examiner argues that the MPEP is merely ambiguous about what is meant by "intent to broaden." However, the MPEP is far from ambiguous on this point. Specifically, the MPEP instructs:

[A] broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue application which was filed *within* two years from the grant. Where any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period.

Thus, a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is different than the broadened claim presented within the two years. Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing (continuation or divisional) reissue application after the two year period.

MPEP § 1412.03(IV) (emphasis added). In this cited passage, the MPEP unambiguously states that an applicant can present a broadened claim after two years if "any intent to broaden" was presented within two years. The phrase "any intent" is simply not consistent with the examiner's alleged ambiguity. But the MPEP does not stop there. As if to anticipate the examiner's argument, the passage goes on to state that claims presented after two years may be presented "even though the broadened claim . . . is different." This cited passage then concludes by

recognizing that it does not matter whether the later-broadened claims are presented in the first reissue or in a continuing reissue application. The MPEP is describing the specific situation in this case. Accordingly, no reasonable interpretation of the MPEP supports the examiner's rejection.

The Examiner's Answer also misinterprets the Federal Circuit's decision in *In re Graff*, 111 F.3d 874, 877 (Fed. Cir. 1997). Appellants cited *Graff* for the general notion, consistent with the MPEP, that the law requires an applicant to put the public on notice of any intent to broaden — rather than a particular scope of broadening, as the examiner proposes. Nevertheless, relying entirely on *Graff*'s dicta, the examiner argues that *Graff* “seems to support the examiner's position.” The Examiner's Answer cites the following passage:

Mr. Graff proposes that it is sufficient if the public has notice that a reissue application had been filed within the two-year period, and that *Doll* charges the public with knowledge that broadening claims may be later added. On this case, the public had no notice that broadening was being sought until after the two-year period. We discern no justification for imposing this degree of uncertainty upon the public. The reissue statute balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights.

Graff, 111 F.3d at 1473-74. But this does not support the examiner's position. In this passage, the court was distinguishing *Doll*, where notice of the intent to broaden existed but not the scope of broadening, with the facts in *Graff*, where “the public had no notice that broadening was being sought until after the two-year period” (emphasis added). Accordingly, *Graff* was concerned only with whether the public was on notice that broadening was being sought, not the scope of the broadening that was being sought. In this way, *Graff* is consistent with all of the other legal authority cited in this appeal, which does not require public notice of specific scope of broadening within the two-year period.

In the Examiner's Answer, the examiner also observes that 37 C.F.R. § 1.175, which governs reissue declarations, has been changed so that a reissue declaration no longer has to identify all errors that an applicant is seeking to correct. Rather, reissue declarations now need to identify only one of the errors that an applicant seeks to correct through reissue. (Examiner's Answer, p. 11.) To the extent this observation is at all relevant to the issue in this appeal, it only further undercuts the examiner's rejection. By requiring an identification of only one error, the rules do not require that the public be put on notice of every "avenue of broadening" that the applicant may seek through reissue, contrary to the examiner's position.

Finally, the examiner argues that original reissue applications are unlike continuing reissue applications because they are published in the Official Gazette so that the public is given an opportunity to review the file to see the scope of the alleged errors. (Examiner's Answer, p. 13.) While this is true, it is noted that continuing reissue applications are also available for public review, including online via the Office's PAIR system. Moreover, when a continuing reissue application has been filed, the public is expressly notified in the published parent reissue patent. *See* 37 C.F.R. § 1.177(a) ("If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date."). Therefore, the examiner's concerns about the lack of notice for continuing reissue applications — in contrast to original reissue applications — rings somewhat hollow.

Summary

For the foregoing reasons, Appellants believe that the examiner's rejection of claims 18-

19 was erroneous and requires reversal by the Board.

In addition, Appellants respectfully request that the Board consider designating its opinion for this appeal as precedential. This same erroneous rejection has been used by the Office in several reissue applications owned by the assignee of this application and likely has been and/or will be used in other reissue applications owned by others. A precedential opinion would benefit the public because it would guide the examination of other pending applications subject to this kind of rejection; it would remove any cloud over the substantial number of existing reissued patent issued under similar circumstances; and it would require the Office examining corps to abide by a decision finding clear precedent in the law, the rules, and even the examiners' own guidebook.

Respectfully submitted,

James D. Kelly and Michael L. Regal

Dated: October 15, 2008

By: /Sabra-Anne R. Truesdale/

Sabra-Anne R. Truesdale, Reg. No. 55,687
Attorney for Applicants
Fenwick & West LLP
801 California Street
Mountain View, CA 94041
Tel.: (650) 335-7187
Fax: (650) 938-5200